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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,558

06/09/2005

Alfred Bernhard

SB-521

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EXAMINER

MAI, NGOCLAN THI

ART UNIT

PAPER NUMBER

1742

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/533,558

Applicant(s)

BERNHARD ET AL.

Examiner

Ngoclan T. Mai

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. Claims 9-18 remain for examination, wherein claims 9, 14 and 16 are amended.
2. Applicant's arguments, see pages 5-6, filed 1/19/07, with respect to claims 9, 12, 13, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-296650 have been fully considered and are persuasive. The rejection of 9, 12-13, 16 and 18 as well as other rejections based on JP 296650 has been withdrawn.
3. Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Claim Rejections - 35 USC § 102*

4. Claims 9, 11, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimada et al. U.S. Patent No. 5,068,149.

Shimada et al discloses cemented carbide containing at least one of cobalt and nickel in an amount of from 4 to 35% by weight, unavoidable impurities and balance tungsten carbide having an average grain size of 0.2 to 1.5 microns, abstract and claim 1. In Table 1, Shimada et al. discloses cemented carbide, e.g., number 14, containing 20% Co and balance WC, wherein WC grain size is 0.5 micron. The cemented carbide is formed into tools such as solid end mills or drill bits that are less susceptible to fracture, col. 3, l. 89-13. Shimada et al is silent about the tools being a torsional load-resistant hard material, however it well known that drill bit is subjected to torsional load during use. Since the tools disclosed by Shimada is formed of the same material and having structure in similarity of the applicant, the tools taught by Shimada inherently is a torsional load resistant hard metal.

Regarding claims 11 and 18, it appears the claimed property is material property. Consequently, the properties as recited in the instant claims would have inherently

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possessed by the teachings of the cited references. "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977).

***Claim Rejections - 35 USC § 103***

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada et al.

Shimada et al discloses cemented carbide containing at least one of cobalt and nickel in an amount of from 4 to 35% by weight, unavoidable impurities and balance tungsten carbide having an average grain size of 0.2 to 1.5 microns, abstract and claim 1.

Shimada et al differs from the claim in that Shimada et al. does not specifically teach tungsten carbide having mean size in a range from 0.7 to 0.9 micron and metal binder in the amount 13-17% by weight Co.

However, since Shimada et al. teaches cemented carbide tool with constituents whose wt% and WC grain size ranges overlap those recited by the claims; such overlapping range renders applicant's composition prima facie obvious despite difference in non-overlapping areas, see In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974). To distinguish over prior art, applicant needs to demonstrate (e.g. by comparative test data) that the more narrowly claimed ranges for the alloying constituents are somehow critical and productive of new and unexpected results.

6. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada et al. in view of Aken et al, U.S. Patent No. 5,399,051 (art previous cited)

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Shimada et al differs from the claims in that Shimada et al does not teach forming the cemented carbide into screwdriver bit

Aken et al. teaches screwdriver include a bit that is very similar to drill bit, that is a driven member include a tank portion and a shank portion wherein the head portion instead of having cutting element will have a screwdriver blade, col. 1, l. 25-29.

Screwdriver blade and drill bit heads are also subjected to torsional stress, col. 2, l. 6-51.

Since screwdriver is very similar to drill bit and subjected to the same environment as drill bit during use, it would have been obvious to of ordinary skill in the art to employ material for drill bit taught by Shimada et al. in making screw driver of the instant claim.

7. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada in view of Aken as stated in paragraphs no. 5 and 6 above and further in view of Holland-Letz (2004/0139829, art of record)

Shimada et al. in view of Aken differs from the claims in that Shimada et al. does not teach method of forming screwdriver bit by injection molding and machining a plurality of parallel web-like elevations.

Holland-Letz discloses it is known to form screwdriver bits by injection molding, see [0003]. Holland-Letz teaches machining the grooves to form parallel-web-like elevation is also known [0005]. Thus it would have been obvious have been obvious to one of ordinary skill in the art at the time the invention was made to form the screwdriver bit employed the material Shimada by injection molding method as this is a well known method for making such object.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoclan T. Mai whose telephone number is (571) 272-1246. The examiner can normally be reached on 9:30-6:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

n.m.

ROY KING   
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700